

REMARKS

Claims 1, 4, 7 and 8 are currently pending in the present application. Claims 1 and 7 have been amended. Support for the amendment of claim 1 may be found in the specification, at least, at page 11, lines 4-21; page 14, last paragraph; and page 23, lines 8-9. Support for the amendment of claim 7 is self-explanatory. No new matter has been added by way of the above amendments.

Applicants respectfully submit that no new issues are raised that would present the Examiner with the burden of additional search and/or consideration. In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

Rejection under 35 USC §102

Claims 1, 4 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by US 2003/0059618 to Takai (hereinafter "Takai").

Takai discloses a resin composition containing an alicyclic epoxy compound having two alicyclic epoxy groups and no ester bond, cationic polymerization initiator and another epoxy compound different from said epoxy compound. In the Office Action, Response to Arguments, at page 3 – page 4, the Examiner appears to suggest that copolymer (F) of Takai is equivalent to component (D) of the claimed invention.

In the present response, claim 1 has been amended as follows:

A thermosetting resin composition comprising 100 parts by weight of an epoxy composition (E) and 0.01 to 20 parts by weight of a cationic polymerization initiator (C), and ***1 to 50 parts by weight of an epoxy-containing acrylic resin (D)*** different from components (A) and (B) to 100 parts by weight of the epoxy composition (E),

wherein the epoxy-containing resin (D) is prepared by polymerizing an epoxy-containing monomer including compounds each having a glycidyl group or a terminal epoxy group analogous to the glycidyl group and wherein the

epoxy group content of the epoxy-containing acrylic resin (D) is 4% to 12%, in terms of oxirane oxygen content,

the epoxy composition (E) comprising 10 to 99 percent by weight of an ester-free alicyclic epoxy compound (A) having two alicyclic epoxy groups and no ester bond per molecule; and 90 to 1 percent by weight of another epoxy compound (B) differing from the epoxy compound (A), the total of (A) and (B) being 100 percent by weight. (emphasis added)

As shown in Table III-1 in Takai, the epoxy group content of copolymer (F) is 1.4% to 2.7%, in terms of oxirane oxygen content. *See* Takai, paragraph [0244]. Thus, for at least this reason, the presently claimed epoxy-containing acrylic resin (D) is not the same as the copolymer (F) disclosed in Takai.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Since Takai does not teach each and every limitation of the claimed invention, Applicants respectfully submit that the present claims cannot be anticipated by Takai, within the meaning of 35 U.S.C. § 102(b).

Further, Applicants respectfully submit that the presently claimed epoxy-containing acrylic resin (D) obtains unexpectedly superior results, which rebuts any potential allegation of the obviousness of the presently claimed invention.

As shown in Table 2 of the present specification (page 30), the inclusion of component (D-2) (prepared by polymerizing an epoxy-containing monomer including compounds each having a glycidyl group or a terminal epoxy group analogous to the glycidyl group) improves the optical transparency of the thermosetting resin composition. For instance, a comparison of Examples 1, 2, 3, 5 and 7 (does not contain component (D-2)) with Examples 4 and 6 (contains component (D-2)), reveals that Examples 4 and 6 obtain better optical transparency, demonstrating the superior results attained from component (D-2).

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: January 29, 2009

Respectfully submitted,

By 

MTL Marc S. Weiner
Registration No.: 32,181
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant